



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/982,796	10/22/2001	Tatsuya Yanagisawa	05721.0020	8412

22852 7590 05/13/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

NGUYEN, CAM LINH T

ART UNIT PAPER NUMBER

2161

DATE MAILED: 05/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/982,796

Applicant(s)

YANAGISAWA ET AL.

Examiner

CamLinh Nguyen

Art Unit

2161

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. This Office Action is response to the RCE filed 4/4/2005.
2. Applicant's amendments to claims 1 – 15 are acknowledged. Consequently, claims 1 – 15 are currently pending in this application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1 – 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Richard Stokes (U.S. 4,870,515).

♦ As per claim 1,

Richard Stokes (U.S. 4,870,515) discloses a music piece data managing apparatus comprising:

- “ A storage part for storing music piece data and management data associated therewith in a manner allowing additional writing” See Fig. 1, Fig. 4, col. 5, lines 35 - 38. “ The storage part” corresponds to the data terminal 42. “ Management data” corresponds to the artist or tile data that stored together with the music pieces (see abstract). As seen in Fig. 1, the tape is allowed to write data into the tape (portable tape player 40, col. 5, lines 44 – 50) for later reproducing. Therefore, this is “allowing for additional writing”.

Art Unit: 2161

- “ A display part for displaying the data management data stored in said storage part and display a message to prompt an input operation for instructing an order of reproduction of said music piece data” See Fig. 4, element 112, col. 6, lines 52 - 58. Stokes teaches that the system will prompt for selection of choices such as artist, titles (col. 9, lines 12 – 13), and Fig. 15 is a display of management data that waiting for user selections.
- “ A reproducing order generating part for forming reproducing order data to determine an order of reproduction of music pieces by correlating said input operation with said management data” see col. 6, lines 10 - 28. “said input operation” corresponds to the operation of user to select the music or to program the selections.
- “ A data transfer part for transferring said reproducing order data to another storage part outside said music piece data managing apparatus” see col. 6, lines 64 – col. 7, lines 39. The data is transferred from RAM 110 (located in the terminal 42) to the portable device memory or from memory to tape, or from tape to tape (col. 2, lines 19 – 21, col. 3, lines 30 – 40).

♦ As per claim 2, Stokes discloses:

- “ Said reproducing order generating part rearranges said management data in accordance with the reproducing order of the music pieces and allocates edition numbers representing the order of reproduction to said management data, thereby forming the reproducing order data” See col. 2, lines 33 – 38, col. 6, lines 19 – 27. The user can rearrange the order of music pieces according to user’s desires (col. 8, lines 15 – 23).

♦ As per claims 3 – 4, Stokes discloses:

Art Unit: 2161

- “ Said management data includes a music piece name of the music piece data, data indicative of attributes of said music piece, and a memory address indicative of a storing position of said music piece data in said storage part” see col. 8, lines 15 – 23.

◆ As per claims 5, 9, 12, Stokes discloses:

- “ Said reproducing order generating part generates said reproducing order data and adds additional writing data comprising the music piece data and the management data associated therewith which have been additionally written onto said storage part to said formed reproducing order data” See col. 2, lines 3 – 30.

◆ As per claims 6 - 7, Stokes discloses:

- “ A portable data recording medium is used” See col. 5, lines 49 – 51.

◆ As per claims 8, 10 – 11, Stokes discloses:

Richard Stokes (U.S. 4,870,515) discloses a music piece data managing apparatus comprising:

- “ A storage part for storing music piece data and management data associated therewith in a manner allowing additional writing” See Fig. 1, Fig. 16, col. 4, lines 49 – col. 5 lines 10. “ The storage part” corresponds to the tape that recorded the music pieces. “ Management data” corresponds to the artist or title data that stored together with the music pieces (see abstract). As seen in Fig. 1, the tape is allowed to write data into the tape for later reproducing. Therefore, this is “allowing for additional writing”.
- “A transfer data reading part for reading the reproducing order data transferred by said data transfer media” col. 10, lines 20 – 26.
- “ A reproduction control part for collating the reproducing order data read by said transfer data reading part with the management data stored in said storage part and

Art Unit: 2161

controlling reproduction of the music piece data stored in said storage part based on the order of reproduction designated by said reproducing order data” See col. 9, lines 17 – 20, col. 2, lines 3 – 38.

- “ A data transfer part for transferring said reproducing order data by a data transfer media” see col. 2, lines 3 – 38.

◆ As per claims 13 - 14, Stokes discloses:

- “ Said reproducing order data is transferred to said another storage part by using a memory medium” see col. 6, lines 64 – col. 7, lines 39. The data is transferred from RAM 110 (located in the terminal 42) to the portable device memory by connection bus.

◆ As per claims 15, Stokes discloses:

- “ Said reproducing order data is transferred to said another storage part by using a radio wave apparatus” See col. 5, lines 11 – 34.

Response to Arguments

5. Applicant's arguments filed 08/05/04 have been fully considered but they are not persuasive.

Applicant argues that Stokes fails to disclose a data transfer part for transferring reproducing order data to another storage part outside music piece data managing apparatus. The Examiner respectfully disagrees.

Referring to Fig. 2, col. 5, lines 35 - 38, Stokes discloses a terminal 42, which is corresponding to the managing storage part. At col. 2, lines 19 – 21, col. 3, lines 30 – 40, Stokes teaches that data can be directly transferred to another tape, tape-to-tape, memory-to-tape, or tape-to-memory. Since the terminal includes the memory, the music is transferred from this

Art Unit: 2161

terminal to a portable player device (40). Therefore, the data must transfer outside music piece data managing apparatus.

Applicant argues that Stokes fails to disclose the limitation of forming reproducing order data based on the input operation. The Examiner respectfully disagrees.

Referring to col. 6, lines 19 – 28, col. 8, lines 15 – 23, col. 8, lines 15 – 23, Stokes clearly teach that the selection from the user is programmed so that the system will form reproducing order data based on the input operation.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kupka et al (U.S. 6,434,535) discloses a system for prepayment of electronic content using removable media and for prevention of unauthorized copying of same.


7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CamLinh Nguyen whose telephone number is (571) 272-4024. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on (571) 272-4023. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 2161

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

LN



ALFORD KINDRED
PRIMARY EXAMINER